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EXAMINER

NGUYEN, LINH THI

ART UNIT

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/519,851	Applicant(s) ITO, MASANORI	
	Examiner LINH T. NGUYEN	Art Unit 2627	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 16 October 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-17 and 20-26 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-10, 12-16 and 20-26 is/are rejected.
- 7) ☒ Claim(s) 11 and 17 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 22, 23, and 25 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

Claims 22, 23 and 25 are drawn to a computer readable medium having stored thereon a computer program, where the computer readable medium as defined in the specification on page 39, lines 24-25 and page 40, lines 1-2 can be a signal or carrier wave or paper; therefore, fail(s) to fall within a statutory category of invention.

A claim directed to a computer readable medium having stored thereon a computer program, where the computer readable medium as defined in the specification can be a signal or carrier wave or paper, covers a signal or carrier wave or paper which are non-statutory as noted, infra.

A claim directed to a computer program itself or signal or carrier wave is non-statutory because it is not:

A process occurring as a result of executing the program, or

A machine programmed to operate in accordance with the program, or

A manufacture structurally and functionally interconnected with the program in a manner which enable the program to act as a computer component and realize its functionality, or

A composition of matter.

A claim directed to a paper having thereon a computer program is non-statutory, because it covers printed matter which is non-statutory. It is not until the program is converted into an electronic form to be read and executed by the processor that it becomes functional descriptive material. There is no functional relationship between the paper and the computer program (see *In re Gulack*, 217 USPQ 401, *In re Lowry*, 32 F.3d 1579, 32 USPQ2d 1031 (Fed.Cir.1994)). The program as disclosed is merely printed on the paper, hence the program is merely non-functional descriptive material, therefor, the claimed paper with a computer program printed on it is non-statutory. See *Ex parte S*, 25 JPOS 904, *Ex parte Glenn*, 155 USPQ 42, *In re Lockert*, 65 F.2d 159, 17 USPQ 515.

See MPEP § 2106.01. Data structures not claimed as embodied in computer readable media are descriptive material per se and are not statutory because they are not capable of causing functional change in the computer. See, e.g., *Warmerdam*, 33 F.3d at 1361, 31 USPQ2d at 1760 (claim to a data structure per se held nonstatutory). Such claimed data structures do not define any structural and functional interrelationships between the data structure and other claimed aspects of the invention, which permit the data structure's functionality to be realized. In contrast, a claimed computer readable medium encoded with a data structure defines structural and functional interrelationships between the data structure and the computer software and hardware components which permit the data structure's functionality to be realized, and is thus statutory. Similarly, computer programs claimed as computer listings per se, i.e.,

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the descriptions or expressions of the programs are not physical “things.” They are neither computer components nor statutory processes, as they are not “acts” being performed. Such claimed computer programs do not define any structural and functional interrelationships between the computer program and other claimed elements of a computer, which permit the computer program's functionality to be realized.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-10, 12-14, 20-22, and 25 are rejected under 35 U.S.C. 102(b) as being anticipated by Kikuchi et al (US Patent Number 6532334).

In regards to claims 1, 20, 22, and 25, Kikuchi et al discloses a recording/reproducing apparatus (Fig. 15) comprising: a reproducing unit that extracts recorded video signals from a recording medium (Fig. 15, element 32) in which said video signals have same contents but are compressed in a plurality of different bit rates (Column 13, lines 10-13) and record management information (Figs. 6-14) that denotes a mutual association between said video signal that have the same contents but are compressed in a plurality of different bit rates (Column 13, lines 15-59); a decoding unit that decodes any of said video signals extracted from said recording medium (Fig. 15, element 60); and recording unit that records (Fig. 1, element 13), a recording unit that

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records, in correspondence to said record management information (Figs. 3, 4, 6 and 9), reproduction management information including reproduction-interruption information for defining a point of interruption in time when a user interrupts a reproduction of said video signals from said recording medium (Column 18, lines 25-62), wherein said signals are decoded according to a selected bit rate from said point of interruption in time (Fig. 9; Column 11, lines 59-67).

In regards to claim 2, Kikuchi et al discloses the reproducing apparatus according to claim 1, wherein said recording unit records said reproduction management information on said recording medium (Column 13, lines 29-35).

In regards to claim 3, Kikuchi et al discloses the reproducing apparatus, further comprising a built-in flash memory, wherein said reproduction management information is recorded on said flash memory (Fig. 15, element 34, Column 14, lines 16-43).

In regards to claims 4 and 21, Kikuchi et al discloses an apparatus, method and program, wherein said reproducing unit (Fig. 15) further extracts said reproduction management information from said flash memory (Column 14, lines 48-51), and based on the said record management information and said reproduction management information, extracts, from said recording medium, signals after signals corresponding to said reproduction interruption information included in said reproduction management information (Column 14, lines 48-67).

In regards to claims 5/1, 5/2, 5/3 and 5/4, Kikuchi et al discloses the reproducing apparatus, wherein said reproduction interruption information concerns elapsed time from start of reproduction of said signal (Column 18, lines 48-67).

In regards to claim 6, Kikuchi et al, wherein said recording unit (Fig. 1, element 100) further records, in correspondence to said record management information and said reproduction management information (Fig. 7), identification information of said recording medium on said flash memory (Fig. 1, element 34).

In regards to claim 7, Kikuchi et al discloses the reproducing apparatus, wherein said reproducing unit further extracts said record management information, said reproduction management information, and said identification information of said recording medium (Figs. 3, 4, 6, 9 and 15), any of signals extracted from said recording medium is suitable for said reproducing unit and/or said decoding unit (Fig. 15, elements 60), and said reproducing unit, based on said record management information, said reproduction management information, and said identification information of said recording medium, further extracts, from said recording medium, signals after signals corresponding to said reproduction interruption information included in said reproduction management information (Fig. 9; column 15, lines 5-49).

In regards to claim 8, Kikuchi et al discloses the reproducing apparatus, wherein said different conditions concern different bit rates, different numbers of pixels, or different compression methods (Column 13, lines 1-18).

In regards to claim 8, Kikuchi et al discloses the reproducing apparatus according to claim 1, wherein said video signals are compressed in a plurality of different conditions including any one of different numbers of pixels and different compression methods (Column 13, lines 10-14).

In regards to claim 9, Kikuchi et al discloses the reproducing apparatus, wherein said video signals can be continuously reproduced on the recording medium (Column 15, lines 55-67) said video signals that have the same contents but are compressed in a plurality of different bit rate are recorded (Column 13, lines 10-14).

In regards to claims 10, 12 and 13, Kikuchi et al discloses the reproducing apparatus, wherein each of which has size that is equal to or larger than a predetermined size (Figs. 3, 4, and 5) wherein said signals that have the same contents but are compressed in a plurality of different bit rate are recorded (Column 13, lines 1-18)

In regards to claim 14, Kikuchi et al discloses the reproducing apparatus, wherein said decoding unit (Fig. 15, element 60) further decodes signals compressed in a plurality of different bit rate that are extracted from said recording medium (Column 15, lines 30-49).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim 15 is rejected under 35 U.S.C. 103(a) as being unpatentable over Kikuchi et al in view of Applicant Admitted Prior Art (AAPA).

In regards to claim 15, Kikuchi et al do not but AAPA discloses the reproducing apparatus, wherein said different compression methods are MPEG2 and MPEG4, respectively (Paragraph [0002] and [0003]). At the time of the invention it would have been obvious to person of ordinary skill in the art to modify the selection of compression of Kikuchi with MPEG2 and MPEG4 as suggested by AAPA. The motivation for doing so would have been to record/reproduce with lower bit rate.

Claims 16, 23 and 26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Okita et al (JP Patent Application Publication 2001169250) in view of Yogeshwar et al (US Publication Number 20040096110).

In regards to claims 16, 23 and 26, Okita et al discloses a recording method, comprising the steps of: (a) recording, on a recording medium (Fig. 1, element 31) and record management information (Fig. 1, element 28; Paragraphs [0059] and [0062]); (b) extracting said video signal recorded on said recording medium (Fig. 1, element 17); (c) decoding said video signal extracted in step (b) (Fig. 1 element 19), wherein are recorded in continuous data area, each of which has size that is equal to or larger than a predetermined size (Fig. 2, the predetermine size is form 0-30), and said continuous data areas are recorded in a form of being repeatedly alternately arranged (Fig. 2, the second recording from 0-20-30-50 are alternately arranged). However, Okita et al does not but Yogeshwar et al discloses a method wherein (a) video signals that have same contents (video/audio data) but are compressed in a plurality of different bit rates (Fig. 5) that denotes a mutual association between said signals that have the

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same contents but are compressed in a plurality of different bit rates (Paragraph [0095]). At the time of the invention it would have been obvious to a person of ordinary skill in the art to modify the data of the recording medium of Okita with that of Yogeshwar et al, for the purpose of providing mutual association video signals that have the same content but compressed in plurality of different bit-rates. The motivation for doing so would have been to increase the pictures quality (abstract).

Allowable Subject Matter

Claims 11 and 17 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Response to Arguments

Applicant's arguments with respect to claims 1, 20, 22, and 25 have been considered but are moot in view of the new ground(s) of rejection.

Applicant's arguments filed 10/16/08 have been fully considered but they are not persuasive. In regards to claims 16, 23, and 26, applicant argues that Yogeshwar does not disclose "same contents to have different bit rates." However, Yogeshwar discloses that the encoding format can be change from one encoding to another if user does not accept the image quality (Paragraph [0072]). Yogeshwar suggested that different received data or applications are paired up with selected encoding formats MPEG1, 2

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or 4 (Paragraphs [0061]-[0068]), however, the user can choose different encoding formats (Paragraph [0106]) and different formats have different bit rates.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to LINH T. NGUYEN whose telephone number is (571)272-5513. The examiner can normally be reached on 10:00am-7:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Wayne Young can be reached on 571-272-7582. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

LN

January 7, 2009

/Wayne Young/

Supervisory Patent Examiner, Art Unit 2627